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09/839,433	04/20/2001	Claude Jarkae Jensen	10209.56	1737
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KIRTON AND MCCONKIE 60 EAST SOUTH TEMPLE, SUITE 1800 SALT LAKE CITY, UT 84111			EXAMINER	
			LANDAU, SHARMILA GOLLAMUDI	
			ART UNIT	PAPER NUMBER
			1611	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/839,433

Applicant(s)

JENSEN ET AL.

Examiner

Sharmila Gollamudi Landau

Art Unit

1611

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 7-12, 22 and 27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 7-12, 22, 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Receipt of Request for Continued Examination and Amendments/Remarks filed on 9/20/07 is acknowledged. Claims **1, 7-8, 11-12, 22, and 27** are pending in this application. Claims 2-6, 9-10, 13-21, 23-26, and 28-30 stand cancelled.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The rejection of claim 12 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in light of the amendments of 9/20/07.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 12 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant amended claim to recite the ozokerite in an amount between about 5 and 10%. Although the original claims support the range of 5-20% ozokerite, the instantly amended range is not supported in the originally filed specification and claims. If applicant contends there is

support for the above ranges, the examiner requests applicant point to the specific page and line where said support may be found.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 7-8, 11-12, 22, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP2000-095663 (application number 10269482) to Kondo et al in view of Elkins (Hawaiian Noni, 1998) in further view of Vatter et al (6,224,888).

JP teaches a plant extract such as *Morinda citrifolia* for external use. These plant extracts have various properties such as skin whitening abilities, antioxidants effects, and antimicrobial effects, which make them effective for external use. See abstract. The plant extract is utilized in the amount of 0.0005-5% and JP discloses the use of instant *Morinda citrifolia* in the amount of 4.8%. *Morinda citrifolia* is used in the examples. Note Table 2 and page 4 of the translation. The plant extract is extracted from the branch, trunk, bark, bloom, fruit (contains the juice), roots, or other dry matters. The fruit is exemplified. Note that the fruit contains the juice and the seed, which contains the oil. See page 3. The external applications taught are milky lotion, cream, a pack, foundation, **lipstick**, shampoo, and conditioner and in the form of a liquid, salve, gel, etc. See page 2 and examples. Kondo et al teach additives such as lower alcohols, polyhydric alcohols, oily components (paraffin, squalene, cetyl alcohol), antioxidants, surfactants, thickeners, astringents, UV absorbents (octyl methoxycinnamate), vitamins, etc. in the cosmetic

compositions. See examples and page 4. Examples teach the squalene in the amount of 5% and octyl methoxycinnamate in the amount of 5%. It should be noted that linoleic acid and xerone are inherent components of *Morinda citrifolia* fruit.

JP does not specify the part of the fruit utilized, i.e. the fruit seed oil or the fruit juice. Further, the reference does not teach the instant ozokerite.

Elkins teaches the usage of noni for over hundreds of years for its therapeutic actions (antimicrobial, antioxidant, and emollient benefits). Elkins teaches that *all* parts of the noni plant such as the fruit, the seeds (which contains the oil), bark, leaves, and flowers are utilized. See page 9-11. One of the most prevalent uses of noni is as a skin healing agent due to the presence of proxeronine and the skin's response to it. See page 30.

Vatter teaches a cosmetic composition including skin care products that treat and care for the skin, i.e. moisturize or improve the condition of the skin. See column 2, lines 20-25. Further, Vatter teaches utilizing a "solidifying agent" that solidifies liquid base materials to be used in a cosmetic composition. This solidifying refers to the physical and/or chemical alteration of the liquid base material so as to form a solid or semi-solid at ambient conditions, i.e., to form a final composition, which has a stable physical structure and is deposited on the skin during normal use conditions. The selection of the particular solidifying agent for use in the cosmetic compositions will depend upon the particular type of composition desired, i.e., gel or wax-based, the desired rheology, the liquid base material used and the other materials to be used in the composition. The solidifying agent is preferably used in an amount from about 3% to about 20%. Solidifying agents include wax-like materials include cetyl alcohol, waxes including paraffin, ceresin, **ozokerite, white beeswax**, synthetic waxes, and **mixtures thereof**. The waxy materials may

also serve as emollients. See column 8, lines 10-45. Additionally Vatter teaches an emollient as essential to the compositions. The emollient component aids in the application and adhesion of the composition to the skin and most importantly provides occlusive moisturization. Suitable oils include esters, triglycerides, hydrocarbons and silicones are used in the amount of 5% to about 90% and most preferably from about 70% to about 90% of the emollient component. Petrolatum is specifically taught. See column 5, lines 20-25, column 6, line 9, and column 6, lines 55-60.

Firstly, although Kondo does not specify the part of the *Morinda citrifolia* fruit utilized, it is would have been obvious to one of ordinary skill in the art to look to the guidance provided by Kondo and Hawaiian Noni and utilize any part of the *Morinda citrifolia* extract in the cosmetic composition, i.e. the fruit seed oil and fruit juice. It should be noted that the fruit contains both the juice and the seed, which contains the oil. One would have been motivated to do so since JP teaches any part of the plant may be utilized and it will impart cosmetic benefits of skin whitening abilities, antioxidants effects, and antimicrobial effects. Hawaiian Noni also teaches that all the parts of the noni plant provide beneficial effects to the skin and have been used for years. Therefore, absent unexpected results, it would have been prima facie obvious for a skilled artisan to utilize all parts of the fruit in a composition and expect benefits to the skin.

Secondly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further look at the teachings of Vatter et al and utilize the instant ozokerite. One would have been motivated to do so with the expectation of success since Kondo teaches the composition may contain additional additives such as thickeners and oily components and Vatter teaches the use of wax hydrocarbon agents not only serve as emollients but also serve to change the rheology of the cosmetic composition to provide the desired structure to the

cosmetic composition, i.e. a solid or semi-solid cosmetic. Therefore, it would have prima facie obvious to utilize the instant ozokerite in the cosmetic composition of Kondo for its dual purpose of serving as an emollient and its ability to change the physical structure of the composition to yield a desired structure, i.e. it acts as a thickener. Moreover, it would have been obvious to further utilize petrolatum in the composition for the advantages taught by Vatter, which include providing adhesion of the composition to the skin, and provides occlusive moisturization. Lastly, a skilled artisan would have expected success by the instant combination since both references are in the same field of endeavor, i.e. skin care products used to moisturize and care for the skin.

Response to Arguments

Applicant argues that the combination does not suggest the claim limitations. Applicant argues that Kondo teaches away from using *Morinda citrifolia* since Kondo discloses that vegetable or fruit extracts fail to be effective. Applicant argues that Kondo indicates on page 2 that the antibacterial effects of the extracts have a low effect.

Applicant's arguments filed 9/20/07 have been fully considered but they are not persuasive. The examiner notes that page 2, paragraph 4 refers to the prior art and not Kondo's invention.

Applicant argues that Kondo teaches the use of the vegetable or fruit extract to inhibit melanin, astringents, antioxidants, and antibacterial agents and lips do not produce melanin. Thus, applicant argues that Kondo's composition cannot be applied to the lips.

First, it should be noted that the recitation "lip treatment" is a intended use limitation. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed

invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In instant case, the composition is non-toxic and is capable of being applied to the skin. Further, Applicant's attention is directed to page 4, paragraph 19, in which Kondo teaches the composition may be formulated into a lipstick.

Applicant argues the Elkins fails to teach the claimed limitations. Applicant argues that Elkins does not teach the use of the seed oil or the amount of oil and juice.

The examiner points out that Kondo teaches that the extract may be from the seed or fruit, wherein the fruit is exemplified, and the extract may be obtained from *Morinda citrifolia*. Further, Kondo teaches the extract in the amount of 0.0005-5%. Thus, the only teaching lacking in Kondo is which part of the fruit is used. Thus, the examiner relies on Elkins to cure this deficiency. Elkins teaches that, "The parts of the noni plant most used for their medicinal and nutritional purposes are the fruit, seeds, bark, leaves, and flowers. Virtually every part of the noni plant is utilized for its individual medicinal properties". Thus, it is within the skill of an artisan to use all parts of the noni plant and expect benefits for the skin. Applicant has not provided any unexpected results to overcome the rejection.

Applicant argues that Vatter does not cure the deficiencies of Kondo and Elkins.

The merits of Kondo and Elkins have been discussed above and are incorporated herein. The examiner relies on Vatter to teaches the instant amount of ozokerite.

Therefore, the rejection is maintained until applicant demonstrates the unexpectedness of the combination of the juice and oil in the instant weight ratio to overcome the obviousness rejection.

Claims 1, 7-8, 11-12, 22, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP2000-095663 (application number 10269482) to Kondo et al in view of Wadsworth et al (WO 01115537) in view of Fisher (Living Better, vol. 1 (5)) in further view of Vatter et al (6,224,888).

JP teaches a plant extract such as *Morinda citrifolia* for external use. These plant extracts have various properties such as skin whitening abilities, antioxidants effects, and antimicrobial effects, which make them effective for external use. See abstract. The plant extract is utilized in the amount of 0.0005-5% and JP discloses the use of instant *Morinda citrifolia* in the amount of 4.8%. *Morinda citrifolia* is used in the examples. Note Table 2 and page 4 of the translation. The plant extract is extracted from the branch, trunk, bark, bloom, fruit (contains the juice), roots, or other dry matters. The fruit is exemplified. Note that the fruit contains the juice and the seed, which contains the oil. See page 3. The external applications taught are milky lotion, cream, a pack, foundation, **lipstick**, shampoo, and conditioner and in the form of a liquid, salve, gel, etc. See page 2 and examples. Kondo et al teach additives such as lower alcohols, polyhydric alcohols, oily components (paraffin, squalene, cetyl alcohol), antioxidants, surfactants, thickeners, astringents, UV absorbents (octyl methoxycinnamate), vitamins, etc. in the cosmetic compositions. See examples and page 4. Examples teach the squalene in the amount of 5% and octyl methoxycinnamate in the amount of 5%. It should be noted that linoleic acid and xeronine are inherent components of *Morinda citrifolia* fruit.

JP does not specify the part of the fruit utilized, i.e. the fruit seed oil or the fruit juice. Further, the reference does not teach the instant ozokerite.

Wadsworth et al teaches morinda citrifolia oil, which can be used in cosmetics and massage oils (page 4). The reference discloses that morinda citrifolia is an essential oil that contains several different fatty acids (page 4 and Table 1). The oil is obtained from the fruit seed.

Fisher teaches that French Polynesian used the juice for various ailments such as skin problems (abscesses, abrasions, wounds, infections, and boils).

Vatter teaches a cosmetic composition including skin care products that treat and care for the skin, i.e. moisturize or improve the condition of the skin. See column 2, lines 20-25. Further, Vatter teaches utilizing a “solidifying agent” that solidifies liquid base materials to be used in a cosmetic composition. This solidifying refers to the physical and/or chemical alteration of the liquid base material so as to form a solid or semi-solid at ambient conditions, i.e., to form a final composition, which has a stable physical structure and is deposited on the skin during normal use conditions. The selection of the particular solidifying agent for use in the cosmetic compositions will depend upon the particular type of composition desired, i.e., gel or wax-based, the desired rheology, the liquid base material used and the other materials to be used in the composition. The solidifying agent is preferably used in an amount from about 3% to about 20%. Solidifying agents includes wax-like materials include cetyl alcohol, waxes including paraffin, ceresin, **ozokerite, white beeswax**, synthetic waxes, and **mixtures thereof**. The waxy materials may also serve as emollients. See column 8, lines 10-45. Additionally Vatter teaches an emollient as essential to the compositions. The emollient component aids in the application and adhesion of the composition to the skin and most importantly provides occlusive moisturization. Suitable oils include esters, triglycerides, hydrocarbons and silicones are used in the amount of 5% to about

90% and most preferably from about 70% to about 90% of the emollient component. Petrolatum is specifically taught. See column 5, lines 20-25, column 6, line 9, and column 6, lines 55-60.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use *Morinda citrifolia* oil and juice in the cosmetic composition with the expectation of similar results since Kondo suggests the use of *Morinda citrifolia*. One would be motivated to use morinda citrifolia is that Wadsworth teaches the instant oil contains essential fatty acids, known for their conditioning properties and Fisher teaches the use of the instant plant extracts for its wound healing properties, both of which are useful for skin purposes. Therefore, the prior art establishes that the oil and juice are applied to the skin.

Secondly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further look at the teachings of Vatter et al and utilize the instant ozokerite. One would have been motivated to do so with the expectation of success since Kondo teaches the composition may contain additional additives such as thickeners and oily components and Vatter teaches the use of wax hydrocarbon agents not only serve as emollients but also serve to change the rheology of the cosmetic composition to provide the desired structure to the cosmetic composition, i.e. a solid or semi-solid cosmetic. Therefore, it would have prima facie obvious to utilize the instant ozokerite in the cosmetic composition of Kondo for its dual purpose of serving as an emollient and its ability to change the physical structure of the composition to yield a desired structure, i.e. it acts as a thickener. Moreover, it would have been obvious to further utilize petrolatum in the composition for the advantages taught by Vatter, which include providing adhesion of the composition to the skin, and provides occlusive moisturization. Lastly,

a skilled artisan would have expected success by the instant combination since both references are in the same field of endeavor, i.e. skin care products used to moisturize and care for the skin.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharmila Gollamudi Landau whose telephone number is 571-272-0614. The examiner can normally be reached on M-F (8:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sharmila Gollamudi Landau/
Primary Examiner, Art Unit 1611